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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/556,647
Filing Date: April 24, 2000
Appellant(s): BAUER, MITCHELL R.

MAILED

JUL 13 2004

GROUP 3600

Francis L. Conti
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 22, 2003 (Paper No. 21).

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. All rejections are related to the previous Final Office Action mailed October 18, 2003 (Paper No. 18). There are two independent claims: claims 15 and 22. These two claims are noted in bold typeface below.

In Summary:

Invention I: Claims 1-7 Restricted Out

Invention II: Claims 8-14 Restricted Out

Invention III: Claims 15-21 :

15-18	Prior Art Rejections (Salvo (103) & Purcell (102))
19, 20	Objected to only
21	Prior Art Rejections (Salvo (103) & Purcell (102))

Invention IV: Claims 22 and 31-39

22	Prior Art Rejections (Salvo (102 & 103) & Purcell (102 & 103))
31-33	Prior Art Rejections (Salvo (102 & 103) & Purcell (102 & 103))
34-38	§112 2 nd Paragraph Rejections Only in Final Office Action
39	Prior Art Rejections (Salvo (102 & 103) & Purcell (102 & 103))

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims on appeal do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,341,271	Salvo et al	1-2002
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5,940,807	Purcell	8-1999
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6,324,522 B2	Peterson et al	11-2001
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White, Ron, How Computers Work, Millennium Ed. Que Corporation, 9/1999.

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Derfler, Frank J. et. al. How Networks Work, Millennium Ed., Que Corporation, 1/2000.

Gralla, Preston, How the Internet Works, Millennium Ed., Que Corporation, 8/1999.

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims. All rejections were set forth in the Final Office Action mailed on October 22, 2003 (Paper No. 18).

Invention III: Claims 15-18, and 21

Purcell

Claims 15-18 and 21 are rejected under 35 U.S.C. §102 user Purcell.

Claims 15-18 and 21 are alternatively rejected under 35 U.S.C. §103 user Purcell.

Salvo

Claims 15-18 and 21 are rejected under 35 U.S.C. §103 user Salvo.

Invention IV: Claims 22 and 31-39

Salvo

Claims 22, 31-33, 39 are rejected under 35 U.S.C. §102 user Salvo.

Claims 22, 31-33, 39 are alternatively rejected under 35 U.S.C. §103 user Salvo.

Purcell

Claims 22, 31-33, 39 are rejected under 35 U.S.C. §102 user Purcell.

Claims 22, 31-33, 39 are alternatively rejected under 35 U.S.C. §103 user Purcell in view of Peterson.

112 2nd

Claims 34-38 are rejected under 35 U.S.C. §112 2nd Paragraph only.

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(11) Response to Argument

1. This appeal can be essentially broken down into two section. The first section relating to the claims are rejections of Invention IV (claims 22 and 31-39). The second section relates to Invention I (claims 15-18 and 21).
2. For arguments not found in this Brief, See the Examiner Final Rejection mailed October 21, 2003.

Summary of the Examiner's Arguments

3. Claims claims 22 is indefinite under 35 U.S.C. §112 2nd paragraph under two separate and independent grounds. Once the Board of Patent Appeals and Inferences (Board) finds that this is the case, all claims in Invention IV must also be rejected under §112 2nd paragraph.
4. Invention II is also rejected under §§ 102/103 in view of either Salvo or Purcell/Peterson. Once the Board finds all claims in Invention II as rejected, Applicant's implied admission that the Invention III stands or falls with Invention IV compels the rejection of all claims in Invention III.

Invention IV (claims 22 and 31-39)

35 U.S.C. §112 2nd Paragraph Rejections

1st §112 2nd Paragraph Rejections – Combination/Subcombination

5. The Final Office Action stated:

In claim 22, it is unclear whether Applicant is claiming the subcombination of the apparatus or the combination of the apparatus and the computer system.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination (*e.g.* the computer system *in addition to* the information itself; or the computer system *in addition to* the computer program; or the computer system *in addition to* the network

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including the local area network, the Internet, the server, host, and/or ISP, etc. as shown in Figure 1), the Examiner respectfully requests Applicant to clarify this matter by indicating it as so. For purposes of *appeal only*, the Examiner has interpreted the claim as a combination claim including all physical structures shown in Figure 1. If Applicant expressly states on the record that this is a combination claim, this particular 35 U.S.C. §112 2nd rejection will be withdrawn.

6. This rejection simply asks what does Applicant intend to claim. The Examiner has considered all arguments of record and finds that the computer program is not part of the claim.

In his Petition under Rule 113 and Rule 181 (2nd Petition) filed December 19, 2003 (Paper No. 19), page 6, Applicant expressly states "Claim 22 initially recites means 104, 106, 112 ... for storing ... in a computer system" Applicant's Appeal Brief on page 6 confirms Applicant's position.

7. The final Office Action also stated

Claim 22 begins "An apparatus" Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a). Therefore, it is the Examiner's position that Applicant's apparatus claims (*i.e.* claims 22 and 31-39) are clearly "product" claims or more specifically, "machine" claims. Next, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). With this in mind, Applicant is reminded that "apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Final Office Action, Page 10, Paragraph No. 18.

8. Its entirely possible that Applicant's means phrases also included the computer program since the physical structure of the medium changes when the program is stored thereon. In such a case "a computer-implemented means-plus-function claim is limited to a computer programmed to perform the algorithm disclosed in the specification." *Creo Products Inc. v. Presstek Inc.*, 305 F.3d. 1337, 1345, 64 USPQ2d 1385, 1389 (Fed. Cir. 2002) citing *WMS Gaming, Inc. v. Int'l*

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Game Tech., 184 F.3d 1339, 1348, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999). For this to apply however, Applicant had to indicate however that the computer program was part of the structure that performed the function.

9. Although Applicant presents conflicting arguments, the Examiner finds claims 22 is therefore indefinite since its unclear what elements make up the combination claim.

2nd §112 2nd Paragraph Rejections – Corresponding Structure

10. In a related 112 2nd paragraph rejection, Applicant has failed to clearly link and associate the corresponding structure to the means phrases. Again, Applicant has offered conflicting viewpoints. The Examiner has considered all evidence of record and finds Applicant's arguments on page 7 of his brief and page 4 of his 2nd Petition to be more credible than his other arguments. There Applicant argues that means for storing is 104, 106, and 112. While Applicant's brief and petition sets forth the corresponding structure, the specification does not. Evidence to support this is the Group Director's Decision (Paper No. 20 mailed April 28, 2004). Therefore, Applicant indicates that the corresponding structure in the means phrases is not and can not include the computer program.

11. However 112 is a display. It is the Examiner's factual determination that a display is not structurally necessary for performing the claimed function. The display can not be corresponding structure for Means Phrase #1.

12. Applicant argues on page 24 of his brief that that the means for displaying is "112/302." A review of the specification will show that element 302 is not even structure. For this reason alone, claim 22 is indefinite.

13. The Examiner agrees that the various structures cited by both the Examiner and Applicant are *capable* of being the corresponding structure, but this however is not the test. The duty to clearly link and associate is an affirmative duty. Guesswork will not suffice. In other words, “[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

14. Moreover, structures that are “capable of” being corresponding structure are not necessarily corresponding structure. See *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001) where Federal Circuit held that although alternative structures shown in the specification were “capable of performing the recited function,” they were nevertheless not “clearly linked or associated” to the recited function and therefore could not be considered corresponding structure. The final office action gave many examples of possible corresponding structure. Applicant even argues various examples. Because Applicant is statutorily incorporating the specification to the claims, examples in the claims create 112 2nd paragraph rejections. It is up to Applicant to clearly link and associate those structures to the claimed function.

Because Applicant has failed to clearly link and associate the corresponding structure in the specification to the functions recited, claim 22 is indefinite.

15. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell*

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International Inc. v. ITC, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art was applied *as much as practically possible*.

35 U.S.C. §102 Rejections

16. Assuming the claims are definite (which the examiner does not), claims 22 and 31-39 are rejected under §102 by wither Salvo or Purcell.

17. Anticipation is a question of fact. *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869). “To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Moreover, “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at

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1701. See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*.

18. In this case, the Examiner cited three (3) references of what information is within the skilled artisan's own knowledge. The Final Office Action, Page 30, Paragraph No. 45, stated:

In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these three references are directed towards beginners (see e.g. "User Level Beginning . . ."), because of the references' basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03, the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

19. Applicant's brief at pages 74-75 confirms the Examiner position. Applicant recites "The three references are cited by the examiner for the minimum, yet substantial level of skill in the computer art, and Applicant agrees that those skilled in the art would possess substantially more knowledge"

20. In fact, Applicant proffered disclosure of what is old and well known in the art goes even further. Applicant's brief confirms that *How Computers Work* is *alone* enough to show the corresponding structure for claim 22:

This very reference [*How Computers Work*] provided by the Examiner is clear evidence that the various means elements recited in the claims would not be in any way ambiguous to those of ordinary skill in the art. Applicant's Brief, Page 13.

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The claimed invention is embodied in a computer system having various operative components, well recognized by the Examiner *and in his own citation of How Computers Work*. [Emphasis added.] Applicant's Brief, Page 16.

21. Because Applicant admits that How Computers Work is clear evidence that the various means elements are known to those skilled in the art, because the structure disclosed in How Computers Work is the structure embodying Applicant's invention, the Examiner concludes that the corresponding structure is disclosed in the prior art. Because of *In re Graves*, this disclosure is in effect incorporated within both Salvo and Purcell.¹

22. Having established the corresponding structure (whatever it is) is known to those skilled in the art, the only issue remains is does the corresponding structure perform the claimed function. Applicant's own brief confirms that it does.

23. Applicant recites:

To the contrary, these very references provided by the examiner are clear evidence that those skilled in the art would know how to program and operate computer-based inventions to achieve the functions specified by Applicant, and manipulate the specific data fields also specified in Applicant's disclosure and claims. Applicant's Brief, Page 75.

24. Because Applicant admits that one skilled in the art would be able to program a computer to perform the claimed functions, the functions to are old and well known in the art.

25. Finally, the Examiner notes that a description of an item is indicative of intended use of the item. For example, a "bicycle tire" indicates that its use is on a bicycle and not e.g. a tractor. A

¹ "The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader." *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) citing *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans").

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“tractor tire” indicates a use on a tractor and not a bicycle. Because all the references disclose description either directly or inherently, they all disclose the claimed criteria indicative of intended application. In fact, Salvo discloses the use of “polyvinylchloride piping” [Salvo Column 10, 20-26]. See also Applicant’s brief, Page 31, for what Applicant admits Salvo discloses.

26. Regarding claim 31, a known monitor is configured to display virtually any information monitors are capable of displaying, including customer application criteria.

27. Regarding claim 32, an ordinary computer mouse is configured for selecting the various claimed elements.

28. Regarding claim 33, an ordinary computer hard drive is configured for storing virtually any information. As long as the hard drive has space, it is “configured” to store the claimed elements.

29. Regarding claim 39, the means for storing is the CPU. Applicant argues that

30. Purcell directly discloses that the description is stored.

31. Both Purcell and Salvo disclose the claimed invention, should the Board find a technical violation by the Examiner thus negating a 102 rejection, the Examiner has provided alternative 103 rejections to support and small differences. The Examiner encourages the Board to use the cited three How reference “” to fill in any gaps they encounter

Invention III (claims 15-18, and 21)

32. Having established that Group IV is not patentable over the prior art, the Examiner notes that claims 15-18 and 21 are rejected as being obvious in view of Applicant’s implied admission that the inventions are not patentably distinct.

33. The Examiner notes that Applicant has admitted that the groups of inventions are related.

34. According to MPEP §803, where two groups of inventions are related, a restriction is proper if the examiner can meet a two prong analysis: (1) if the inventions are distinct, and (2), the examiner establishes a serious burden.

Element 1: Are the Inventions Distinct

35. In *In re Lee*, 199 USPQ 108 (ComrPats 1978), applicant petitioned to withdraw a restriction requirement. The Commissioner noted that:

In the situation where the inventions in question are ‘related’, it is necessary, to support a restriction requirement, to show that they are ‘distinct’. MPEP 802.01 defines ‘distinct’ as necessitating that the inventions, inter alia, be patentable over each other.” *In re Lee*, 199 USPQ at 109.

36. The Examiner concludes as a matter of law that for related inventions, prong (1) essentially requires that two inventions to be patentably distinct over each other.

37. Applicant has not yet admitted that the groups of inventions are patentably distinct. Should Applicant specifically state this on the record, the Examiner might reconsider the restriction.

Element 2: Serious Burden

38. In class 705, a serious burden can be determined by ascertaining if the groups of inventions are patentably distinct. A hypothetical will illustrate this point.

First and for simplicity of argument, assume that a hypothetical patent application has two groups of inventions: group I has claims 1-10 (directed to *e.g.* a product) while group II consists of claims 11-20 (directed to *e.g.* a process). It is also easier to assume that claims 1 and 11 are independent claims (although this is not necessarily required). All claim limitations in claims 1-10 will be summarized at “AB.” Also in our hypothetical patent application, assume that group II

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(claims 11-20) contains some of the same limitations as group I (the “B” limitations) but group II also includes some *additional* limitations “C.” In summary, our hypothetical patent application has two groups; group I (claims 1-10) has limitations “AB” while group II (claims 11-20) has limitations “BC.”

The analysis is straight forward. If the two groups of inventions (groups I and II) are not patentably distinct, a restriction is clearly improper. See *e.g. In re Gold*, 42 USPQ2d 1095, 1096 (ComrPats 1996)(Unpublished)(holding that because of applicant’s admission that the two groups of inventions stand or fall together, applicant has made an implied admission that the groups of inventions are not patentably distinct—the restriction is therefore improper).

However on the other hand, if the inventions *are* patentably distinct, limitations “C” in group II *must* (by definition) contain patentably distinct features. Because of the mandatory search requirements for allowance in class 705,² the Examiner would be *required* to search for limitations “C” and perform additional template searches—even if limitations “AB” were searched and considered allowed. This additional searching for limitations “C” is a different field of search and is therefore *prima facie* evidence of a serious burden on the examiner. See MPEP §808.02.

The same is true if group II (claims 11-20, limitations BC) were elected and allowed. In that case, the Examiner would be *required* to search for limitations “A” and perform additional template searches—even if limitations “BC” was searched and considered allowed. This additional searching for limitations “A” is a different field of search and also *prima facie* evidence of a serious burden on the examiner. See MPEP §808.02.

² See *Notification of Required and Optional Search Criteria for Computer Implemented Business Method Patent Applications in Class 705, and Request for Comments*, Federal Register, Vol 66, No. 108, June 5, 2001.

Conclusion

The Examiner concludes that, as a matter of law, if two groups of related inventions are each patentably distinct from each other (*i.e.* group I is patentably distinct from group II, and group II is patentably distinct from group I), the mandatory search requirements for allowance in class 705 will automatically create a serious burden on the Examiner. Thus, the Examiner can always meet the serious burden prong if the two groups of inventions are patentably distinct. Having established that prongs (1) and (2) are each met, *inter alia*, by showing that the groups of inventions are patentably distinct, the examiner has established a *prima facie* case for restriction. This question of whether the inventions are “patentably distinct” is therefore ultimately the determinative question for restriction between related inventions in class 705.

Why Group III is not Patentably Distinct from Group IV

39. In this case, Applicant has stated “‘querying the user for seller input’ is not a different process at all, let alone a materially different process. Both claims 1 and 8 recite **substantially verbatim** the same user input query [Emphasis Applicant’s]”³

40. The Examiner found the groups of inventions to be patentably distinct. Applicant stated that this was “distorted logic.”⁴ Moreover, Applicant invited Applicant to use the petition to narrow the issues. “Perhaps the results of this petition may be used to advantage (*sic*) in reducing the issue on appeal.”⁵ Applicant goes on to state:

³ First Petition to withdraw Restriction filed July 23, 2003, Page 4.

⁴ First Petition, Page 5.

⁵ First Petition, Page 14.

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Note the one-to-one correspondence between the six method elements of the method claim 15 and the corresponding six “means for” elements in apparatus claim 22. The two claims could not be any better “linked” in accordance with the express MPEP requirements.⁶

41. It appears Applicant is using the generic form of the term ‘link.’ Applicant’s response filed January 14, 2003, Applicant states that “it is noted that apparatus claim 22 is the mean-for equivalent of method claimed 15 under MPEP 809.03.”⁷

42. Because Applicant has stated that the groups of inventions are “substantially verbatim” in combination with the evidence noted above, the Examiner finds that Applicant has made an implied admission that the groups of inventions stand or fall together. See MPEP 803 and its citation to *In re Lee*, 199 USPQ 108 (ComrPats 1978).

(11) Response to Arguments

43. Applicants discussion of “safe harbour provisions” (page 10) to overcome the 112 2nd paragraph is not persuasive because the safer harbour provision are related to §101 and there are no §101 rejections in this application.

44. Applicants in depth discussion of 112 1st Paragraph (page 11 of brief) is also not persuasive. There are no 112 1st paragraph rejections in this application (nor was there ever a 112 1st paragraph rejection in this application).

45. Regarding Applicants misunderstanding of 37 C.F.R. §1.111(b), Applicant must point out only errors. If the Applicant agrees, §1.111(b), does not require the in-depth discussion Applicant sets forth.

⁶ First Petition, Page 14.

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46. Applicant's traversal (page 12 of the brief) of each and every use of a case citation is acknowledged.
47. Applicant's discussion of best mode (brief, Page 19, bottom paragraph) is not persuasive because there are no best mode rejections in this application.
48. Regarding Applicant's position that the Examiner has afforded no weight to the functional limitations, the Examiner disagrees. Applicant confuses the terms "considered" and "weight."
49. Applicant's request for how to amend a claim (brief, page 33, 4th full paragraph) is declined.
50. The Examiner notes that Applicant has not requested an interview.
51. Regarding Applicant's statement on page 26 of his brief that "The lengthy record is quite clear that this examiner and this attorney clearly can not agree to anything" The Examiner disagrees. For example, both agree that claims 19 and 20 are allowable if put into independent form.
52. Applicant's discussion of "old case law" on page 28 is not persuasive.
53. Applicant's statement as to what are conclusions of law is acknowledged.
54. For the above reasons, it is believed that the rejections should be sustained.
55. An appeal conference was held on July 6, 2004 with Supervisory Patent Examiner Robert Olszewski and Supervisory Patent Examiner John Weiss.

⁷ Applicants "Remarks" submitted with Amendment B, January 14, 2003, Paper No. 11, Page 10.

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The Examiner requests an oral hearing if it would help in the disposition of this appeal.

Respectfully submitted,



Andrew J. Fischer
Examiner
Art Unit 3627

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